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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,127	01/18/2006	Robert H. Wohleb	090238-00178	7811
36993 7590 12/11/2009 CRAIN, CATON & JAMES FIVE HOUSTON CENTER 1401 MCKINNEY, 17TH FLOOR HOUSTON, TX 77010				
EXAMINER LUDLOW, JAN M				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 12/11/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/565,127

Applicant(s)

WOHLEB, ROBERT H.

Examiner

Jan M. Ludlow

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 9, 15-18, 21, 22, 26-30, 35-37 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 15-18, 21, 22, 26-30, 35-37 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-4, 8-9, 15-18, 21-22, 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the negative limitation to the "cap having no orifices therethrough". The text cited by applicant does not state such a negative limitation.
2. The amendment filed August 19, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The limitation to the cap having no orifices therethrough is not supported.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Forsyth (6825046).

Forsyth teach a vessel 6 with neck and opening capped by cap 3A, 4A having porous sorbent coated surface 1A. (col. 3, lines 36-60; Figures 3-4). The cap is applied to the vessel, analyte extracted, the coating portion withdrawn into a tube within the cavity of the cap, the cap removed and the fiber placed in a second vial for extraction prior to injection into an analyzer (col. 4, lines 5-37). It is the examiner's position that the Teflon seal is penetrable within the crimp cap as was known in the art.

7. Claims 26-27, 29-30, 35, 45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth.

Forsyth fails to teach the Teflon seal as a stopper (i.e., a cap having a sidewall within the neck of the vessel), or recapping the first vessel and capping the second.

It would have been obvious to provide the Teflon seal of Forsyth in the form of a stopper as an alternative known sealing member for a crimp or screw top vial as was known in the art.

It would have been further obvious to provide a second cap on the first vessel in order to preserve for future testing and/or prevent spillage as was known in the art. It would have been obvious to provide the entirety of the first cap to the second vial in order to completely and/or partially seal it during the second extraction process so as to prevent evaporation and/or contamination as was known in the art.

8. Claims 8-9, 15, 21-22, 28, 36-37, 42-44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth as applied to claims above, and further in view of Pawliszyn (2002/0178797).

Forsyth fails to teach a particulate coating.

Pawliszyn teaches a device similar to that of Forsyth. The fiber can be coated with particulate [0080].

It would have been obvious to coat the fiber of Forsyth with particulate in order to sorb analytes as taught by Pawliszyn.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rits additionally teaches a coated cap with sorbent and penetrable port.

10. Applicant's arguments filed August 19, 2009 have been fully considered but they are not persuasive.

11. The rejection over Lee is overcome because, e.g., the cap of Lee contains a venting orifice.

Applicant argues that the coating of Forsyth is applied to a cylindrical support mounted through a silicone septum and surrounded by a tube. However, the instant claims do not require that the cap be made of a unitary structure and do not preclude a protrusion as the coated interior surface of the cap. Note further that in Fig. 4, the fiber is not shown as protruding through the cap or including the tube 3, and that there are no orifices in the cap in that the cap is airtight, as in the instant disclosure. With respect to claims 26 and 29, the lower periphery of the fiber is smaller than the top of the cap and coated, and with respect to claim 45, Forsyth teaches plural coatings (col. 4, lines 10-15).

With respect to claims 35 and 44, the examiner argued: It would have been further obvious to provide a second cap on the first vessel in order to preserve for future testing and/or prevent spillage as was known in the art. It would have been obvious to provide the entirety of the first cap to the second vial in order to completely and/or partially seal it during the second extraction process so as to prevent evaporation and/or contamination as was known in the art. The examiner regrets that these claims were left out of the claim listings by typographical error and has corrected the action above.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday, Tuesday and Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jan M. Ludlow
Primary Examiner
Art Unit 1797

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